

- put CI
- 31
1. (Amended) A process for preparing isocyanates comprising reacting an amine or a mixture of two or more amines with phosgene containing a positive amount of less than 50 ppm of bromine or iodine or their mixtures in molecular or bound form.
  2. (Amended) A process as claimed in claim 1, wherein the phosgene contains a positive amount of less than 25 ppm of bromine or iodine or mixtures thereof in molecular or bound form.

### REMARKS

Applicants respectfully request entry of the foregoing amendments and reconsideration of the application in view of the accompany remarks. Upon entry of this Amendment, claims 1-6 and 10-19 remain pending in the application. Claims 7 and 20-24 have been cancelled. Claims 1 and 2 have been amended. Support for the amendment can be found throughout the specification.

#### Preliminary Remarks

The Examiner stated that references cited in the international search report have been considered to the extent possible. However, no mention is made of the references submitted by Applicants in an Information Disclosure Statement or of the PTO Form 1449 submitted therewith, copies of which are enclosed herewith.

Applicants respectfully request that the Office confirm receipt of such references by returning the PTO Form 1449 with the Examiner's initials next to the references submitted by Applicants.

#### Remarks Regarding Substantive Rejections

The Office has objected to the specification. The Office states that the present application must contain a specific reference to the prior application in which benefit is desired in the first

sentence of the specification or in an application data sheet in conformance with 37 CFR 1.78(a)(2) and (a)(5).

Applicants wish to point out that an application data sheet was submitted with the application when filed originally with the Office, which includes a specific reference to the application in which the benefit is desired. A copy of the application data sheet as filed with the original application is enclosed herewith.

Claims 7 and 20-24 stand rejected under 35 U.S.C. §102(b) as being anticipated by Yamamoto et al. Since claims 7 and 20-24 have been cancelled, this rejection is no longer relevant.

Claims 1-6 and 10-19 stand rejected under 35 U.S.C. §102(b) as being anticipated by Yamamoto et al. The Examiner states that Yamamoto discloses a two-stage process for the reaction of diaminodiphenylmethane with phosgene in chlorobenzene, reacting with an excess of phosgene below 20°C and again at 150°C at atmospheric pressure. The Examiner further states that Yamamoto is silent with regard to the bromine content of the phosgene employed and so no bromine is considered to be present.

Applicants respectfully traverse the rejection. As the Office is no doubt aware, a rejection under 35 U.S.C. §102 can only be maintained if single reference teaches each and every element of the claims. As such, in a rejection under §102 the Examiner cannot ignore any differences between the claims and the reference. If there are any differences whatsoever between the reference and the claim(s), the rejection cannot be based on 35 U.S.C. §102. Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

In the amended claims, Applicants clarify that the phosgene contains a positive amount of less than 50 ppm of bromine or iodine or a mixture thereof. The low bromine or iodine content

is a particular feature of the phosgene used in the process according to the present invention. The Examiner states that since Yamamoto is silent with regard to the bromine content of the phosgene employed, no bromine is considered to be present. Thus, the Yamamoto reference fails to anticipate Applicants' claimed invention.

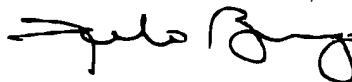
According to Applicants' invention, a phosgene having the specified low bromine and iodine level is used and a clear product is obtained without performing any cleaning step.

Applicants therefore submit that the rejection has been overcome and respectfully request withdrawal of the §102(b) rejection.

### CONCLUSION

Applicants respectfully submit that the claims are in a condition for allowance. A Notice to that effect is respectfully solicited. The Examiner is encouraged to contact the undersigned if such would facilitate the successful prosecution of the instant application.

Respectfully submitted,



BASF Corporation  
1609 Biddle Avenue  
Wyandotte, MI 48192  
(734) 324-6193

Fernando A. Borrego  
Attorney for Applicants  
Reg. No. 34,780

**APPENDIX A - Amended Claims with Markings to Show Changes Made****IN THE CLAIMS:**

Claims 7 and 20-24 have been cancelled.

Claims 1 and 2 have been amended as follows:

3. (Amended) A process for preparing isocyanates [by] comprising reacting an amine or a mixture of two or more amines with phosgene containing a positive amount of less than 50 ppm of bromine or iodine or their mixtures in molecular or bound form.
4. (Amended) A process as claimed in claim 1, wherein the phosgene contains a positive amount of less than 25 ppm of bromine or iodine or mixtures thereof in molecular or bound form.